

the core layer of Asakura by using the porous layer of Sadamitsu to in part increase the breakage resistance and thickness conformity. The Applicants have previously explained that one skilled in the art would have no motivation to make the combination but, that in any event, the combination would fail to disclose, teach or suggest the Applicants' claimed biaxially oriented white polypropylene films. One of the aspects previously emphasized has been the failure of Sadamitsu to even mention the claimed term "cushion fashion" much less disclose, teach or suggest what that cushion factor should be. In response, the rejection insists that the Applicants provide "some evidence as to why the structure of Sadamitsu would not be able to achieve the instantly claimed cushioning factor." The rejection also states that it would have been obvious to optimize the cushion factor of the porous film of Sadamitsu to achieve necessary cushioning properties as disclosed in Asakura.

The rejection further acknowledges the Applicants' point concerning unexpected results but states that there is no evidence that the Sadamitsu film with its range of pore sizes and void volumes would not achieve the claimed cushioning properties and thus the results are not considered unexpected.

The Applicants respectfully submit that Sadamitsu does not, in fact, disclose the claimed "cushion factor." Thus, one skilled in the art would not look to Sadamitsu for teachings concerning that unmentioned cushion factor. Inasmuch as Sadamitsu fails to disclose the term, there are no teachings or suggestions that the cushion factor is important, and there are no teachings or suggestions as to how the cushion factor could or should be modified and that there would be any benefit that could or would be obtained by any such optimization. There simply is no motivation to look to Sadamitsu for cushioning factor.

Nonetheless, the Applicants respectfully submit that even if one skilled in the art were to hypothetically import the porous film of Sadamitsu into Asakura, the result that the Applicants achieved with respect to cushion factor is completely unexpected based on the teachings of Sadamitsu (and Asakura). This point is demonstrated by the enclosed Declaration of Mr. Ryosuke Matsui. Mr. Matsui conducted comparative experiments for the Applicants' claimed subject matter and that of Sadamitsu. In particular, Mr. Matsui's Declaration contains an Example 1 that was based on the teachings of this application. The Declaration also includes an example conducted in accordance with the teachings of Sadamitsu. That example is shown on page 19 of Sadamitsu under "Example 1 (Method II)."

After conducting those two experiments, Mr. Matsui conducted several measurements on the resulting films. In particular, porosity and cushion factor was determined for each of the films produced in accordance with the methodology of the Applicants and that of Sadamitsu. Those results are shown on page 6 of Mr. Matsui's Declaration.

The Applicants respectfully submit that the cushion factor results were quite surprising. Specifically, the cushion factor for the Sadamitsu film was 4%. This is in complete contrast to the cushion factor produced in accordance with this application which was 23%.

What does this mean? First, one skilled in the art would not look to Sadamitsu for teachings concerning the cushion factor because it is not disclosed. Assuming *arguendo* that one skilled in the art did look to Sadamitsu for teachings with respect to the cushion factor, one skilled in the art would have had to have conducted an experiment such as the one conducted by Mr. Matsui because, as noted above, there is no discussion of cushion factor in Sadamitsu. Upon conducting such an experiment, one skilled in the art would have produced a film having a cushion factor of around 4%. Then, further assuming *arguendo* that one skilled in the art would

combine the porous layer of Sadamitsu with Asakura, one skilled in the art would anticipate that the resulting film would have a cushion factor on the order of about 4%.

However, the Applicants unexpectedly discovered that the cushion factor far exceeds 4% as demonstrated in the side-by-side comparison in Mr. Matsui's Declaration wherein the cushion factor is 23%. That is a cushion factor nearly six times greater than the Sadamitsu cushion factor. The Applicants respectfully submit that a cushion factor of more than five times greater is indeed surprising and indeed quite unexpected based on what one skilled in the art could and would reasonably glean from an experiment taken directly from Sadamitsu.

The Applicants respectfully submit that Mr. Matsui's Declaration provides the requested evidence as to why the structure of Sadamitsu would not be able to achieve the instantly claimed cushioning factor. Mr. Matsui demonstrates that Sadamitsu does not provide the instantly claimed cushioning factor. Moreover, Mr. Matsui's Declaration also demonstrates that even if one skilled in the art were to look to the undisclosed cushion factor of Sadamitsu, those teachings would lead those skilled in the art to reasonably believe that the cushion factors would be around 4% which is far below the Applicants' claimed minimum of about 16%. Mr. Matsui's Declaration also demonstrates still further beyond the Applicants' original Specification that the Applicants' cushion factor of 23% is above the claimed cushion factor of about 16%.

The Applicants therefore respectfully submit that they have fully demonstrated surprisingly and unexpected results by a direct comparison with the closest prior art employed to reject the solicited claims. The Applicants therefore respectfully submit that such a factual showing of unexpected results more than overcomes the rejection based on the hypothetical combination of Sadamitsu with Asakura.

In light of the foregoing, the Applicants respectfully submit that the entire application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'TDC', written above the printed name.

T. Daniel Christenbury  
Reg. No. 31,750  
Attorney for Applicants

TDC/vp  
(215)656-3381